

REMARKS

As a preliminary matter, Applicant requests that the United States Patent & Trademark Office (USPTO) reconsider the Response dated October 17, 2006 since the USPTO failed to address the amendments made to the claims. In particular, Applicant requests that the USPTO address the “S-shaped spring” amendment to the claims.

Claims 1-29 are pending. Claims 1, 4-7, 9-13, 19-22, and 25-29 are rejected under 35 U.S.C § 102(b) based upon U.S. Patent No. 5,115,291 issued to Stokes.

Claim 1 relates to an accelerometer that includes “a first substrate coupled to the first terminal of the accelerometer, said first substrate being said first plate of the first capacitor.” “[A] second substrate bonded to said first substrate.” The second substrate includes “a moveable mass coupled to the second terminal of the accelerometer, said moveable mass being the second plate of the first capacitor and a first plate of the second capacitor.” “[A]t least one S-shaped spring coupled to said moveable mass and said second substrate.” “[A] third substrate bonded to said second substrate, said third substrate coupled to the third terminal of the accelerometer, said third substrate being the second plate of the second capacitor, wherein the moveable mass is prevented from moving in a direction that inelastically flexes the at least one S-shaped spring.”

Figure 4 of Stokes depicts flexures 19 added to four sides which decrease sensitivity. In contrast, the claimed invention is amended to include S-shaped springs depicted in Figures 7-8. S-shaped springs maintain sensitivity while increasing resistance to shock.

Claims 2-3 and 23-24 are rejected under 35 U.S.C § 103(a) based upon Stokes further in view of U.S. Patent No. 5,954,751 issued to Chen. Applicants respectfully submit that the United States Patent & Trademark Office (USPTO) failed to meet the motivation to combine references standard. In KSR v. Teleflex and Technology Holding Co., No. 04-1350, p.6 (Fed. Cir. 2005) (non-precedential

opinion by Schall joined by Mayer and Prost), the Federal Circuit summarized the law related to the motivation to combine references standard.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” Dembiczak, 175 F.3d at 999; see also Ruiz, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” Dembiczak, 175 F.3d at 999. **Therefore, we have consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular manner claimed.** See, e.g., In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” (emphasis added)); In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“**In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.**” (emphasis added)).

Here, the USPTO merely cited to a positive feature described in Chen. Specifically, the USPTO stated that a skilled artisan would combine Stokes and Chen to produce a smaller implantable medical device. However, merely citing to a positive feature found in a reference does not meet the motivation to combine references standard. The USPTO must clearly explain why a skilled artisan would combine the references in the manner claimed. Withdrawal of the instant rejections and issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

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Date

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